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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,516	04/13/2004	Christopher Warren	02-102	3276
34590	7590	05/11/2006	EXAMINER	
JOHN E. SIMMS JR. 8056 PHILADELPHIA ROAD LOWER LEVEL BALTIMORE, MD 21237			PELTZER, GERARD R	
			ART UNIT	PAPER NUMBER
			3637	

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,516

Applicant(s)

WARREN, CHRISTOPHER

Examiner

Gerard Peltzer

Art Unit

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 6-8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claims 1-5, drawn to class 052, subclass 390.
2. Claims 6-8, drawn to class 264, subclass 125.

Inventions 1 and 2 are related as process of making and product made. In the instant case the process as claimed can be used to make another and materially different product such as a doormat or non-tile flooring or roofing sheets. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with John E. Sims on 4/27/2006 a provisional election was made without traverse to prosecute the invention of Claims 1-5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The following is the action on the merits of the elected Claims 1-5.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 and depending Claims 2-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant refers to "said base layer contacting said substrate" in the claim and it is unclear whether applicant is claiming the substrate as part of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Becker et al, U.S. Patent No. 4,791,015. For Claim 1, Becker describes a multi-layer surface covering suitable for use as a floor tile (column 2, lines 40-41), comprising a porous base layer (column 2, lines 46-47) having communicating interstitial spaces (column 5, lines 45-52), a flexible and resilient membrane layer (column 2, lines 61-64, column 6, lines 31-32) bonded to the base layer (column 3, lines 27-28), and a hard and durable top layer (column 3, lines 32-34 and 60-62) overlaid on and bonded to the membrane layer (column 3, lines 31-34, column 6, lines 46-49).

For Claim 2, Becker describes a base layer of generally rounded particles (column 5, lines 21-24) in contacting relationship and fused at contact points for forming a solid lattice structure (column 5, lines 45-52).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Becker.

Becker does not show the use of silica sand as the particles in the base layer. Becker does, however, teach the use of various particles including glass and ceramics (column 5, lines 40-42) with the heat-activated phenolic (thermosetting) resin (column 5, lines 45-47). It would have been obvious to one of ordinary skill in the art at the time of the invention to use a commercially available resin coated sand, such as the one from Borden chemicals stated in the specification, as one of the resin coated glass, ceramic, or other inorganic particles of Becker in the base layer of the tile claimed for the purpose of using an easily obtainable component material.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Becker in view of Blom, U.S. Patent No. 5,183,438. Becker does not show a membrane layer consisting of an aliphatic polymer mixed with rubber particles or flexible additives. Blom teaches a membrane layer composed of rubber particles and an aliphatic polymer of polyurethane glue (column 2, lines 34-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the layer of Blom as the membrane layer of the tile of Becker to create the tile claimed for the purpose of adding flexibility to the tile.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Becker in view of Gibbons, U.S. Patent No. 3,928,706. Becker does not show a top layer including colored quartz particles. Gibbons teaches a top layer including quartz particles (column 3, lines 2-3). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teaching of Gibbons to modify the top layer of the tile of Becker to include quartz particles to create the tile claimed for the purpose of providing a hard, durable finish.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Allen, et al, U.S. Patent No. 3,801,421, discloses a membrane layer consisting of rubber particles and polymers. Ott, et al, U.S. Patent No. 4,945,697, discloses a multi-layer floor tile with a porous resilient base layer bonded to a middle layer and a hard and durable upper layer. Tortolo, U.S. Patent No. 4,059,853, shows a rubberized asphalt base material adhesively secured to an intermediate liquid impermeable membrane sheet bonded to a hard and durable top layer. Eren, U.S. Patent No. 5,411,352, teaches a top layer including silica sand.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerard Peltzer whose telephone number is (571) 272-7299. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4/28/2006
GP

LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

A handwritten signature in black ink, appearing to read 'Lanma Mai', written in a cursive style.